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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/632,263

08/01/2003

Dean Leighton Taylor Hallows

5500

7590

06/16/2006

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EXAMINER

STOKES, CANDICE CAPRI

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/632,263	<b>Applicant(s)</b> HALLOWS, DEAN LEIGHTON TAYLOR	
	<b>Examiner</b> Candice C. Stokes	<b>Art Unit</b> 3732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 19-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/31/06</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Claim Objections***

Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The cover has already been claimed as having an elastomeric material.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said nonmetal cover" in line 8. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenstein (USPN 4,060,897) in view of Ferranti (US 2001/0031443). Greenstein discloses a dental instrument (see Figure 1) comprising: a generally cylindrical handle (20) having a threaded opening (26) for receiving a tool tip connector (30); a first metal tip (34); said handle (20) being connected to said first metal (see column 7, lines 64-66) tool tip (34) by said tool tip connector (30), wherein said connector (30) includes an opening (see column 6, lines 66-68) on a first end for receiving said tool tip (34) and a threaded portion (28) on an opposing second end for engaging said threaded opening (26) of said handle (20) to fasten said connector (30) to said handle (20). Ferranti teaches an elastomeric, nonmetal cover 10 as shown in Fig. 2. This also reads on Claim 15. The cover 10 having a central region (as best seen in Figure 4 where "T" is shown) and a first and second enlarged region (17,18) on opposite sides of the central region which are integrally connected to the central region. Also the central region has a central wall having a smallest outer diameter at point of least wall thickness and the first and second enlarged regions (17,18) having a largest outer diameter at the greatest wall thickness at a thickest point on the outer surface of the cover 10. As to Claim 6, Greenstein discloses a second tip 68. To Claim 7, Ferranti teaches raised portions 17,18 on cover 10. Further to Claims 8 and 9, Ferranti teaches a cover 10 formed of "elastomeric material [0012]. Specifically to claims 8 and 20,

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Ferranti does not specifically teach a silicone polymer. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a silicone polymer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

*In re Leshin*, 125 USPQ 416. With further regard for claim 19, Greenstein discloses a second end (100) as best seen in Figure 10 for second tool tip connector (98) and second tool tip (102) with a threaded portion (105) on the second end of the connector (98) for engaging said second threaded opening (106) in handle (20). To claim 21, the handle (20) is considered to be a cylindrical metal tube having a central channel and connector (30) is considered to be a metal tie bar. To claim 10, the use of an adhesive to adhere the cover to the handle is not patentable subject matter, since it is well known in the art that adhere two pieces together may be done by a variety of means including using adhesives.

Further regarding Claims 1-5, 11, and 16, Currie and Ferranti disclose the claimed invention except for the ranges as stated in these claims however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the ranges as stated in the claims, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

As to Claims 12 and 13, Currie and Ferranti disclose the claimed invention except for the cover comprising a plurality of colors. It would have been an obvious matter of design choice to change the color or use any color, since such a modification would have involved a mere change

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in the color of a component. A change in color is generally recognized as being within the level of ordinary skill in the art.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9, 11-16, and 19-21 have been considered but are moot in view of the new ground(s) of rejection. Claim 10 is also rejected.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Stokes whose telephone number is (571) 272-4714. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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Candice C. Stokes

  
**PATRICIA BIANCO**  
**PRIMARY EXAMINER**  
